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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,417	11/25/2003	Billy Slabaugh	2003-IP-010444U1	2700

7590 12/05/2005

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EXAMINER
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BATES, ZAKIYA W

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,417

Applicant(s)

SLABAUGH ET AL.

Examiner

Zakiya W. Bates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-46 is/are pending in the application.  
4a) Of the above claim(s) 1-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-33,35,37,38 and 40-42 is/are rejected.
- 7) ☒ Claim(s) 34,36,39 and 43-46 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11252003,07052005
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-14, drawn to a method of making a particulate slurry, classified in class 427, subclass 212.
  - II. Claims 15-30, drawn to a method of propping a fracture, classified in class 166, subclass 280.1.
  - III. Claims 31-46, drawn to a method of gravel packing a well, classified in class 166, subclass 278.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, as evident by group III.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process, as evident by group II.

3. Inventions II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions they are two different processes having different functions of effects.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and the search required for Group II or III is not required for Group I, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Robert Kent on 11/29/05 a provisional election was made without traverse to prosecute the invention of group III, claims 31-46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

9. The abstract of the disclosure is objected to because the term "the present invention" is stated in lines 1, 3, 4, and 10. Correction is required. See MPEP § 608.01(b).

10. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Objections***

11. Claims 35, 39, 42, 45, and 46 are objected to because of the following informalities:

Claims 35 and 42 recite "the fracturing fluid" which lacks antecedent basis.

Claims 39 and 46 use capitalized terms within the body of the claim. The terms should be lowercased.

Claim 45 recites "the multifunctional material", which lacks antecedent basis. The claim should be amended to depend from claim 44 to overcome this objection.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 31, 32, 33, 37, and 38 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Watkins et al. alone.

Watkins et al. discloses a method of gravel packing that includes a method of installing a gravel pack in a well bore comprising the steps of: providing resin coated particulates wherein the resin comprises a resin that does not completely cure unless it is at least one of: exposed to a temperature above about 175<sup>0</sup>F or exposed to an external catalyst; providing a gravel packing fluid; substantially slurring the resin coated particulates in the gravel packing fluid to create a resin coated particulate slurry wherein the slurry is capable of being stored for at least 2 hours (long periods of time) before use; introducing the resin coated particulate mixture to the well bore such that the resin coated particulates form a gravel pack substantially adjacent to the well bore; and allowing the resin coated particulates to substantially cure. The reference does not

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explicitly teach storing the composition for 2 hours, however the reference does teach the composition being capable of being stored for long periods of time (col. . It is considered an obvious expedient to store the composition for the amount of time necessary prior to placing the composition downhole. The term "long periods of time", when considered in this context, may inherently mean greater than 2 hours. Therefore, it would have been considered obvious to one of ordinary skill in the art at the time the invention was made to have stored the composition for at least 2 hours.

With respect to the depending claims, the reference teaches the limitations as claimed, including high temperature curable resins, a silane coupling agent, temperatures above 175F, and placing a catalyst after-flush in the well.

14. Claims 31-33, 35, 37, and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Justus et al.'095

The applied reference has a common assignee/inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Justus et al.'095 discloses a method that includes a method of gravel packing that includes a method of installing a gravel pack in a well bore comprising the steps of: providing resin coated particulates wherein the resin comprises a resin that does not

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completely cure unless it is at least one of: exposed to a temperature above about 175°F or exposed to an external catalyst; providing a gravel packing fluid; substantially slurrying the resin coated particulates in the gravel packing fluid to create a resin coated particulate slurry wherein the slurry is capable of being stored for at least 2 hours before use; introducing the resin coated particulate mixture to the well bore such that the resin coated particulates form a gravel pack substantially adjacent to the well bore; and allowing the resin coated particulates to substantially cure. With respect to the depending claims, the reference teaches the limitations as claimed, including high temperature curable resins, a silane coupling agent, a fracturing fluid, and temperatures above 175°F. With respect to claim 40, the reference discloses a method of installing a gravel pack in a well bore comprising the steps of: providing tackifier coated particulates; providing a gravel packing fluid; substantially slurrying the tackifier coated particulates in the gravel packing fluid to create a tackifier coated particulate slurry wherein the slurry is capable of being stored for at least 2 hours before use; and introducing the tackifier coated particulate slurry to the well bore such that the tackifier coated particulates form a gravel pack substantially adjacent to the well bore. With respect to the depending claims, the reference teaches the limitations as claimed, including resin tackifier and a fracturing fluid.

***Allowable Subject Matter***

15. Claims 34, 36, 39, and 43-46 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the



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limitations of the base claim and any intervening claims. The claim objections in paragraph 11 above must also be corrected.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zakiya W. Bates (formerly Zakiya Walker) whose telephone number is (571) 272-7039. The examiner can normally be reached on Monday-Friday, 8:30 AM-5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on (571) 272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Zakiya W. Bates  
Primary Examiner  
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November 29, 2005